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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,165	11/01/2001	Joerg Schlieffers	7157-481	7803

27383 7590 09/05/2003

CLIFFORD CHANCE US LLP
200 PARK AVENUE
NEW YORK, NY 10166

EXAMINER

FRECH, KARL D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/016,165	SCHLIEFFERS ET AL.	
	Examiner	Art Unit	
	Karl D Frech	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-01-01 and 01-15-12.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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1. The preliminary amendments filed 11-01-01 and 01-15-02 have been entered as papers numbers 8 and 5 respectively. Claims 1-9,28-30 are now pending.
2. The USPTO file wrapper indicates that an Information Disclosure Statement has been filed on or about 11-01-01. However, this IDS has apparently become separated from the file. Applicant is requested to kindly supply a replacement. Any inconvenience is regretted.
3. The abstract of the disclosure is objected to because there is currently the legal phrase "said" in line 8. This word should be replaced. Correction is required. See MPEP § 608.01(b).
4. Claim 5 is objected to because of the following informalities: it is believed that the term "avoid" should be "ovoid" which has been cancelled from independent claim 1 by the preliminary amendment. Appropriate correction is required.
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under

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37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-9,28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meier et al 6,561,428 in view of Chadima, Jr. et al 6,234,395 or Russell et al 6,412,699. Meier discloses as seen in figure 2a a hand held bar code reader with a head portion along a first axis and a handle portion along a handle axis, the first and handle axis intersect at an angle less than 90 degrees. There is on top of the head portion a display toward the "front" end of the head portion, and a keypad for operator control toward the "rear" end of the head portion. The handle portion is also attached to the head portion near the "rear" end of the head portion. There is disclosed a trigger switch 13t, an electrical connection means 178, and toward the front side of the bottom of the handle portion a transverse "rest area". As seen in the figure the display is "recessed" into the top side of the head portion. Meier does not specifically disclose that the handle and head portions intersect at an angle between 0 degrees and 45 degrees. Both Chadima and Russell disclose hand held bar code readers with head portions and handle portions which intersect at angles which are clearly less than 45 degrees and greater than 0 degrees as seen in the figures. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the intersection of the head and handle portions of Meier at an angle between 0 degrees and 45 degrees as taught by Chadima or Russell. This would allow for a more ergonomically comfortable grasp of the unit. Notice the figures of Chadima and Russell both show thumb depressible

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operation controls. Meier, Chadima and Russell do not specifically disclose the indicator lamp on top of the head portion, the impact resistance of the housing or the touch screen display. However, all of these features are old and well known on hand held bar code scanners. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use an indicator lamp in order to signal a "good read" as is common, to use impact resistant housing material in order to protect the apparatus, and to replace the keypad with a touch screen as they are functional equivalents.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-9,28-30 are rejected under the judicially created doctrine of double patenting over claims 1-14 of U. S. Patent No. 6,158,662 in view of Meier et al 6,561,428 as combined with Chadima, Jr. et al 6,234,395 and/or Russell et al 6,412,699 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the '662 patent claims a housing with a main (head)

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and a handle portion, a trigger switch and a visual display. The '662 patent does not specifically disclose the angle of intersection between the head portion and the handle portion, the impact resistant housing, the indicator lamp or the touch pad. However, Meier as combined with Chadima, Jr. and or Russell specifically disclose all these elements as seen above. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Meier/Chadima/Russell with the claimed limitations of the '662 patent in order to provide an ergonomically comfortable bar code reader.

10. Claims 1-9,28-30 are rejected under the judicially created doctrine of double patenting over claims 6-27 of U. S. Patent No. 6,502,754 in view of Meier et al 6,561,428, as combined with Chadima, Jr. et al. 6,234,395 and/or Russell et al 6,412,699 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the '754 patent discloses a hand held bar code reader with a main portion and a handle portion intersecting at an angle between 0 degrees and 45 degrees, a display, operational input means and a trigger means. The '754 patent does not specifically disclose the indicator means, the impact resistance, or touch pad as currently claimed. However, these are all taught by Meier as combined with Chadima and/or Russell. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of

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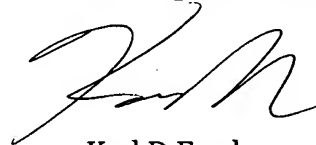
Meier/Chadima/Russell with the claimed limitations of the '745 patent in order to provide a ergonomically comfortable hand held bar code reader.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D Frech whose telephone number is (703) 305 3491. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 308 4075. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.



Karl D Frech
Primary Examiner
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